

**C. REMARKS**

Reconsideration and allowance are respectfully requested.

**Examiner Interview**

Applicants appreciate the participation of Examiner Cheung in the personal interview conducted at the Patent Office on April 22, 2004. The substance of the interview is reflected by the foregoing amendment and the following remarks.

**35 U.S.C. §103(a) Rejection**

The Examiner rejected claims 1-17 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,611,052 to Dykstra et al. ("Dykstra") in view of U.S. Patent No. 6,209,095 to Anderson et al. ("Anderson"). Applicants traverse this rejection for at least the following reasons.

As set forth in the Office Action, the Examiner admits that Dykstra fails to teach or suggest the "comprehensive list of tasks required to comply with federal rules and regulations, state rules and regulations, and local rules and regulations" and "the plurality of task actions comprising a subset of the comprehensive list and disclosing all actions required to process the mortgage loan in compliance with applicable federal or state law."<sup>1</sup> In order to remedy this admitted deficiency, the Examiner relies on Anderson for teaching a "mortgage loan application... designed to be complied with mortgage lending regulations."<sup>2</sup> The Examiner

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<sup>1</sup> See Office action, at p. 4.

<sup>2</sup> *Id.*

alleges that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the mortgage processing method of Dykstra to include the feature of the requiring mortgage application process to be complied with the mortgage lending regulations for preventing illegal loan transactions."<sup>3</sup>

While Applicants do not agree with the Examiner's grounds rejections, independent claims 1, 7, 11, 12, and 15 have been amended in order to expedite prosecution. Namely, Applicants have amended the claims to recite loan origination aspects of the present invention.

Applicants remind the Examiner that in order to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.<sup>4</sup> In addition, there must be a reasonable expectation of success.<sup>5</sup> Moreover, the prior art must teach or suggest all of the claim limitations.<sup>6</sup> Such teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.<sup>7</sup>

Applicants submit that Dykstra and Anderson clearly fail to teach or suggest all the elements of independent claims 1, 7, 11, 12, and 15, as amended. At most, Anderson teaches "[w]hen the document is a mortgage loan application, the document can be designed to comply

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<sup>3</sup> *Id.*

<sup>4</sup> See MPEP § 2143 citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

<sup>5</sup> *Id.*

<sup>6</sup> *Id.*

<sup>7</sup> *Id.*

with mortgage lending regulations."<sup>8</sup> As such, even if Dykstra and Anderson could be combined, which Applicants do not admit, such a combination clearly would fail to teach or suggest all the features of independent claims 1, 7, 11, 12, and 15.

In addition, Applicants contend that the prior art of record, including Dykstra and Anderson, fails to provide any suggestion or motivation to modify the teachings of Dykstra and/or Anderson to provide all the features of independent claims 1, 7, 11, 12, and 15.

In view of the above, Applicants submit that the teachings of Dykstra and Anderson are insufficient to establish a *prima facie* case of obviousness with respect to claims 1-17.

Moreover, Applicants submit that claims 1-17 each recite a combination of features neither taught nor suggested by the prior art, including Dykstra, alone or in combination with Anderson and/or the other references of record, and that such claims are allowable for at least this reason.

Accordingly, Applicants request reconsideration and withdrawal of this rejection.

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<sup>8</sup> See Anderson at col. 10, ll. 65-67.

**D. CONCLUSION**

Applicants submit that the claim of the present application contain allowable subject matter and request favorable action in the form of a Notice of Allowance.

Respectfully submitted,

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